

## **REMARKS**

This is a full and timely response to the non-final Office Action mailed June 19, 2006. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Present Status of Patent Application**

Upon entry of the amendments in this response, claims 1-4, 6-7, and 13-26 are pending in the present application. More specifically, claims 1-4, 6-7, 13-16, 18-19, and 22 are currently amended with no introduction of new matter; claims 17, 20 and 21 are unamended original claims; claims 23-26 have been newly submitted with no new material being added; and claims 5 and 8-12 have been currently canceled. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

#### **A. Allowable Subject Matter**

Applicants wish to place on record their sincere gratitude for Examiner's indication of allowability of claims 19-21 if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in the Office action and to include all of the limitations of the base claim and any intervening claims.

##### **Response to indication of allowability**

Applicants have currently rewritten claim 19 as an independent claim that satisfies the requirements of 35 U.S.C. 112, 2<sup>nd</sup> paragraph and also incorporates pertinent elements of claim 13 from which claim 19 was formerly dependent. Consequently, Applicants respectfully request allowance of independent claim 19 as well as claims 20-21 that each depends directly on claim 19.

#### **B. Rejections under 35 U.S.C. §112**

##### **1) Statement of the rejection pertaining to claims 19-22**

- a) Claims 19-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- b) Claim 19 recites the limitation "the circuit" in line 4. There is insufficient antecedent basis for this limitation in the claim. Claim 13 refers to a "*mixed-signal circuit*" in line 1 and "*an analog circuit*" in line 2. For the purpose of this Office action, the Examiner interprets the limitation "*the circuit*" as "*the mixed signal circuit.*"

- c) Claims 20 and 21 are rejected due to their dependence on claim 19.
- d) Claims 19-22 are rejected due to their dependence on claims 1 and 13 respectively.

**Response to the rejection**

- a) Claim 19 has been rewritten in independent form and is no longer dependent on claim 13, which has been rejected for incorporating the term “*electrically proximate*.”  
Rewritten claim 19 does not include the term “*electrically proximate*.”
- b) The term “the circuit” of claim 19 has been currently eliminated thereby removing any ambiguity in the interpretation of claim 19.

Due to responses a) and b) provided above, Applicants respectfully assert that the rejection of claim 19 under 35 U.S.C. § 112 has been overcome and the claim is now in condition for allowance. Consequently, Applicants hereby request withdrawal of the rejection followed by allowance of claim 19.

- c) Claims 20-21 are dependent on currently amended claim 19 which is now allowable.  
Consequently, Applicants request withdrawal of the rejection followed by allowance of claims 20 and 21.

- d) Claims 19-21 are no longer dependent on claim 13. Claim 22 is directly dependent on claim 13, which is now allowable.

Consequently, Applicants request withdrawal of the rejection followed by allowance of claims 19-22.

**2) Statement of the rejection pertaining to claims 1 and 13**

The term “*electrically proximate*” in claims 1 and 13 is a relative term which renders the claim indefinite.

**Response to the rejection**

Claims 1 and 13 have been currently amended to exclude the term “*electrically proximate*.” Applicants respectfully assert that the rejection of claims 1 and 13 under 35 U.S.C. § 112 has been overcome and the claims are now in condition for allowance. Consequently, Applicants hereby request withdrawal of the rejection followed by allowance of claims 1 and 13.

**3) Statement of the rejection pertaining to claims 2-12 and 14-18**

- a) Claim 2 recites the limitation “*the digital data words*” in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 1 refers to a “*digital data word*” in line 4.

- b) Claim 2-12 and 14-18 are rejected due to their dependence on claims 1 and 13 respectively.

**Response to the rejection**

- a) Claim 2 has been currently amended to eliminate the phrase “*the digital data words*” thereby removing any ambiguity in terms of claim interpretation. Consequently, Applicants request withdrawal of the rejection followed by allowance of claim 2.
- b) Claims 2-4 and 6-7 are dependent on currently amended claim 1 which Applicants respectfully assert is now allowable. Consequently, Applicants request withdrawal of the rejection followed by allowance of claims 2-4 and 6-7, which are allowable as a matter of law due to their dependence on an allowable claim. Claims 5 and 8-12 have been currently canceled thereby rendering moot the rejection of these claims. Claims 14-18 are dependent on currently amended claim 13 which Applicants respectfully assert is now allowable. Consequently, Applicants request withdrawal of the rejection followed by allowance of claims 14-18 and 22, which are allowable as a matter of law due to their dependence on an allowable claim.

**C. Rejections under 35 U.S.C. §102(b)**

**1) Rejection of Claims 1-6, 8-17 and 22**

**Statement of the rejection**

Claims 1-6, 8-17 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Corry et al. (US 5,649,160).

**Response to the rejection**

**Claim 1**

Currently amended claim 1 includes: “performing a write to the acquisition memory when the data is a  $n$ -th data word in a repeating set of  $n$  data words.” The cited prior art of Corry does not disclose “a repeating set of  $n$  data words” where the  $n$ -th data word in the set is written to an acquisition memory. Applicants have described this aspect in their original specification (page 4, line 27 to page 5, line 3 and FIG. 1), reproduced below for easy reference:

In other embodiments, the determination involves no examination of the data word. Instead, the order in which the data word is generated determines whether the data word is a desired data word. For example, every  $n$ -th data word generated in block 102 may be determined to be a desired data word, where  $n$  is an integer.

As is known, a proper rejection under 35 U.S.C. §102(b) requires that a single prior art reference disclose each element of a claim. Furthermore, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. 102(b) followed by allowance of claim 1, because the cited prior art does not disclose at least the above-mentioned aspect of Applicants' currently amended claim 1.

**Claims 2-4 and 6**

Because independent claim 1 is allowable, claims 2-4 and 6 that each depend directly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request allowance of claims 2-4 and 6.

**Claims 5 and 8-12**

Claims 5 and 8-12 have been currently canceled. Consequently, Applicants respectfully assert that the rejection of these claims has been rendered moot.

**Claim 13**

Currently amended claim 13 includes "a memory controller coupled to the memory, the memory controller operable to write to the memory every *n*-th data word in a stream of data words as a desired data word and additionally perform a dummy write to memory for each of the other data words in the stream of data words."

The cited prior art of Corry does not disclose at least this aspect of Applicants' currently amended claim 13. Consequently, Applicants respectfully request withdrawal of the rejection of claim 13 under 35 U.S.C. 102(b) followed by allowance of claim 13.

**Claims 14-17 and 22**

Because independent claim 13 is allowable, claims 14-17 and 22 that each depend directly or indirectly on claim 13 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 102(b) followed by allowance of claims 14-17 and 22.

**D. Rejections under 35 U.S.C. §103(a)**

**1) Rejection of Claims 7 and 18**

**Statement of the rejection**

Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corry et al. (cited *supra*).

## Response to the rejection

### Claim 7

Attention is respectfully drawn to MPEP 706.2(j) *Contents of a 35 U.S.C. 103*

*Rejection*, which states in pertinent part:

To establish a *prima facie* case of obviousness, **three basic criteria** must be met. First, **there must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added)

In rejecting claim 7, the Office action admits that the cited prior art of Corry does not disclose expressly the dummy memory comprising a range of addresses. However, the Office action goes on to state: "at the time of the invention it would have been obvious to a person of ordinary skill in the art to have allowed multiple dummy memory addresses, thereby providing a range of dummy memory address in the memory of Corry," and further that the "motivation for doing so is provided *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), which held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced."

Applicants respectfully traverse the above-mentioned Office action assertions and respectfully assert that the assertions are improper for a variety of reasons. Firstly, while a person of ordinary skill in the art may be motivated to use a range of memory addresses in various applications, claim 7 specifically refers to the use of a range of "dummy" memory locations. The Office action fails to disclose why one of ordinary skill in the art would be motivated to provide dummy memory in the form of a range of memory locations. Certain advantageous aspects of using a range of dummy memory locations have been described in Applicants' specification. For example, in page 6, lines 12-16, the specification points out: "The memory 122 is composed of acquisition memory 123 and dummy memory 125. The dummy memory 125 constitutes a small part of the memory 122 outside the acquisition memory 123 so that when the desired data words are later read out from the acquisition memory, they are not contaminated by data words that are not desired data words." As a further example, in page 8, lines 16-17, the specification points out: "The dummy memory 125 can also be electrically and/or physically separate from the acquisition memory 123."

These aspects are particularly relevant to the objective of claim 7, which is directed towards a method for reducing variations in noise and temperature in a mixed-signal circuit. The aspects described above are not disclosed in Corry. Consequently, a person of ordinary skill in the art would not have a motivation for using multiple dummy memory locations. For at least this reason, Applicants respectfully assert that the rejection fails to satisfy the first of the three criteria under MPEP 706.2(j) for a proper rejection under 35 U.S.C. 103(a).

Furthermore, as mentioned above, the Office action admits that the cited prior art of Corry does not disclose expressly the dummy memory comprising a range of addresses. The cited prior art of Corry not only fails to disclose a range of dummy memory locations but also fails to disclose: “performing a write to the acquisition memory when the data is a  $n$ -th data word in a repeating set of  $n$  data words,” which is a part of claim 1 and thus, a part of dependent claim 7. Consequently, Applicants respectfully assert that the rejection fails to satisfy the third of the three criteria under MPEP 706.2(j) vis-à-vis “the prior art must teach or suggest all the claim limitations.”

For at least the above-mentioned reasons, as well as due to its allowability arising from dependency upon allowable claim 1, Applicants respectfully request withdrawal of the rejection followed by allowance of claim 7.

#### **Claim 18**

The arguments provided above vis-à-vis MPEP 706.2(j), for allowance of claim 7 are equally pertinent to claim 18, which is dependent on claim 13. In the interests of brevity the arguments will not be repeated herein.

Nevertheless, Applicants have opted to currently amend claim 18 to omit the phrase “range of memory locations,” and replace it with subject matter directed at obtaining claim coverage of certain other aspects of the invention.

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 103(a) followed by allowance of claim 18. Allowance is further requested because claim 18 depends on allowable claim 13.

#### **Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

### CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that claims 1-4, 6-7, and 13-26 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative at (404) 610-5689.

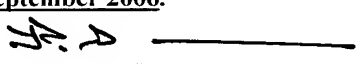
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA, 22313-1450, on 11 September 2006.

  
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